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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/753,863	01/03/2001	Bruce D. Melick	P04337US1	1777
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MCKEE, VOORHEES & SEASE, P.L.C.
801 GRAND AVENUE
SUITE 3200
DES MOINES, IA 50309-2721

EXAMINER

TREMBLAY, MARK STEPHEN

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 06/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,863

Applicant(s)

Melick et al.

Examiner

Tremblay

Group Art Unit

2876

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Applicant: Melick et al.

Filing date: 1/3/2001

Drawings

5 This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required if the application is allowed.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

10 The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15 Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has provided as an example a Welch Allyn Model 3400HD scanner in paragraph 64 of the specification. Examiner has a Welch Allyn Model 3400HD scanner provided by the Office and connected to the personal computer Examiner uses to write Office Actions. To
20 the best of Examiner's recollection, at some much earlier date (Examiner is attempting to ascertain the exact date, since another examiner was present), when Examiner was provided with a 21 inch Hitachi EliteScan monitor, which is capable of refresh rates varying from 60 hz to 85 hz and resolution up to 1600 x 1200 pixels, Examiner attempted to read a bar code on the face of a patent from Examiner's computer monitor in order to input the patent number into an input field
25 of a program used by numerous examiners to create PTO 892 forms. To the Examiner's disappointment but not surprise, the Welch Allyn would not read the displayed bar code, despite numerous adjustments to the resolution, refresh rate, and magnification of the bar code.

30 After reviewing the instant application, Examiner again attempted to read a bar code displayed on the Examiner's workstation, this time using an NEC MultiSync LCD 2110 XtraView monitor. This 21 inch LCD model has a native resolution of 1600 x 1200-- very high end for most computer applications. Because of the properties of LCD displays, this should be easier to

read than the more common CRT monitors. The Welch Allyn 3400HD failed to read any bar code on the screen, despite numerous attempts changing the orientation of the bar code reader, the distance of the bar code reader to the screen, and the magnification and position of the bar code.

Examiner will demonstrate the PTO-provided equipment for Applicant at Applicant's request.

Claims 2, 13, and 17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The claims recite a "high scan rate". This is relative terminology. Applicant has provided no definition of "high scan rate". In the prior art, various artisans have called 40 scans, 100, 500, 800, 1000, and "thousands", etc. per second a "high scan rate". Two orders of magnitude creates a considerable uncertainty in this term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, and 7 are rejected under 35 U.S.C. § 102(b) as being anticipated by USPTO workstations in public use more than one year prior to 1/3/00. The PTO supplied workstation was a bar code data interchange system, comprising:

a first video display (the monitor)

a bar code containing information (e.g. a patent number), the bar code being displayed on the first video display;

a first video displayed bar code reader (the Welch Allyn 3400HD, identified by Applicant as an exemplary video displayed bar code reader);

a first host device (the workstation) operatively connected to the bar code reader.

Re claims 3 and 5, a central computer served patent images containing bar codes.

Re claim 7, the Examiner's workstation ran at that time, a prototype of WEST, or Web Enabled Search Tool, which would display patent images in a web browser.

5 Claims 1, 3, 9, 10, 14, 16 and 18, are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent #5,579,537 to Takahisa ("Takahisa" hereinafter), figure 13 and description thereof.

Claim Rejections - 35 USC § 103

10 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

15 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

25 Claims 4, 6, 8-13, and 15-20 are rejected under 35 U.S.C. § 103 as being unpatentable over the USPTO supplied workstations. USPTO supplies patent examiners with workstations having a bar code reader and a display which displays images of patents containing bar codes as described above. PTO supplied workstations were also used to create PTO-892 forms with a "rapid key" input, which allowed the user to scan in patent numbers directly from the face of a
30 printed patent for citation. In certain instances, such as the citation of patents where all the claims were allowed, there was no need to print the patents because they were not going to be sent to Applicants. This is a well known practice. However, if the examiner did not print out the patents, there would be no printed patent to scan numbers into the rapid-key input. It would have been
35 obvious at the time the invention was made to a person having ordinary skill in the art to use the PTO supplied Welch Allyn 3400 HD scanner to scan in patent numbers directly from the video

monitor to fill out an 892 where documents are cited at the time of allowance, because this would avoid the need to print out the patents, save paper, and reduce errors that may arise if the patent numbers were typed in manually.

5 Re claim 11, the bar codes on the face of the patents were created with software by the printing contractor.

Re claim 18, examiners were called "customers" of both Search and Information Resources Administration in PTO, and the Office of the Chief Information Officer.

10 Re claims 8 and 20, e-mail systems were old and well known. PTO had an e-mail system. It could transmit tif images. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the "e-mail" servers at PTO to transmit tif images containing patent images bearing bar codes because the e-mail system was an equivalent electronic transmission system, which would allow one individual (e.g. a supervisor or primary) could use to transmit a patent image to an intended recipient (e.g. an assistant examiner).

15 Re claims 4, 6, and 19, PTO did not use, to the best of examiner's knowledge, to transmit patent data among examiners. However, there were considerations that would make this obvious. If PTO had decided, for business reasons at that time, to allow examiners to search patents from workstations outside the office, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the Internet via the telephony system to access patents at a remote location, such as a home. Alternatively, PTO provided patent images to
20 outside users at the time via the Internet. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a system like that used by PTO to access patents outside the PTO via the Internet. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to read the patent information from the patent images outside the PTO using a bar code reader because this would allow the outside
25 user to catalog interesting patents automatically, without transcription errors.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent #6,389,182 is cited for showing a computer system which displays bar code

data and decodes it.

U. S. Patent #6,015,088 is cited for showing a bar code reader which reads a video image.

U. S. Patent #5,939,699 is cited for showing a bar code display device.

U. S. Patent #5,872,589 is cited for showing a device which can read codes either from a printed media or from a screen.


U. S. Patent #5,805,152 is cited for showing a bar cod reader which reads from screens.

U. S. Patent #5,379,345 is cited for showing a broadcast system using bar codes.

Japan KOKAI Publication #JP 40 06089362 is cited for showing a bar code reader which extracts data from video.

Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.


MARK TREMBLAY
PRIMARY EXAMINER

June 12, 2002